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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------------|-----------------------------|
| 10/539,461 | 01/28/2008 | John Guest | 033327.0024 | 8391 |
| 1209 | 7590 | 04/27/2011 | | |
| Thomas F. Bergert c/o WILLIAMS MULLEN IP docketing 222 CENTRAL PARK AVENUE SUITE 1700 VIRGINIA BEACH, VA 23462 | | | EXAMINER ADE, OGER GARCIA | |
| | | | ART UNIT 3687 | PAPER NUMBER |
| | | | NOTIFICATION DATE 04/27/2011 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/539,461 | GUEST ET AL. | |
| | Examiner | Art Unit | |
| | GARCIA ADE | 3687 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 69-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 69-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicants' Amendment and Request for Reconsideration filed on **02.15.2011** has been considered.
2. Applicants' response by virtue of amendment to claim 70 has overcome the Examiner's rejection under 35 USC §112, second paragraph.
3. Claim 70 is amended, and claim 71 has been added. Claims 69-71 remain pending in this application.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 69-71** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaschhof et al. [US 2002/0156728] in view of Kaehler et al. [US 2002/0107610], and further in view of Ginter et al. [US 6,363,488].

As per claims 69-71, Jaschhof discloses a method of payment for a product using:

- a mobile radio apparatus having a radio communication circuit and a display capable of displaying an image including a graphical representation of data [see at least the abstract, and as illustrated in figure 1];

- a retail system having a reader capable of reading graphically represented data displayed on said display of said mobile radio apparatus [see at least paragraph 40];
and

- a transaction control system remote from said retail system, said retail system and said transaction control system being capable of communicating over a communications link, said transaction control system storing transaction database records of desired transactions each including data identifying a desired product [see at least summary of the invention], the method comprising the steps of: displaying on said display of said mobile radio apparatus an image including a graphical representation of transaction data which includes data identifying a transaction database record [see at least paragraph 40];

- using said reader of said retail system to read the graphically represented transaction data displayed on said display of said mobile radio apparatus [see at least paragraph 40];

- using said retail system to accept a payment see summary of the invention [see at least summary of the invention]; and

- communicating from said retail system to said transaction control system, the read data identifying a transaction database record and data indicating that payment has been accepted [see at least paragraph 12, via transaction database].

Jaschhof substantially discloses all elements per claimed invention as explained above. Jaschhof does not explicitly disclose a retail system, a reader of said retail system, a transaction control system, displaying an image, updating the transaction database record identified by the communicated data to indicate that payment has been accepted; and delivering the product identified in the identified transaction database record.

However, Kaehler discloses a retail system, a reader of said retail system [see paragraph 27], a transaction control system [see at least the abstract], displaying an image [see claim 30, via image capture], and delivering the product identified in the identified transaction database record [see at least paragraph 37].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teaching of Kaehler to the teaching of Jaschhof in order to provide a remote transaction station containing an inventory of products and at least one special product. The remote transaction station dispenses a special product at random to a customer, and vends a product selected by the customer in the same transaction [see summary of the invention of Kaehler].

The above combination substantially discloses all elements per claimed invention

as explained above. The combination does not explicitly disclose updating the transaction database. However, Ginter discloses updating the transaction database [as illustrated in figure 35].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teaching of Ginter to the teaching of the above combination in order to sufficiently provide impede unauthorized and/or uncompensated use of electronic information and/or appliances through the use of secure communication, storage, and transaction management technologies [see summary of the invention of Ginter].

Response to Arguments

7. Applicants' arguments filed on **02.15.2011** have been fully considered but they are not persuasive.

Applicants argue that Jaschhof does not disclose "using a reader of a retail system to read the graphically represented transaction data displayed on the mobile device display". The Examiner respectfully disagrees. Jaschhof discloses a method for transferring an electronic sum of money from a credit memory associated with a money sender to an account or to a credit memory associated with a money receiver via a mobile radio and IP network in real time using the WAP. Kaehler also discloses in paragraph 27 a Retail System Providing for Transponder Prepayment, of which is incorporated herein by reference in its entirety. Payment device 104 may alternatively comprise an optical reader effective to detect interpretive visual indicia such as a bar

code. Ginter further discloses a process 1150 which can be used by a clearinghouse, VDE administrator or other VDE participant to update the secure database maintained by an end user's electronic appliance.

In response to all of the limitations which Applicants dispute as missing in the applied references in the Amendment and Request for Reconsideration filed on **02.15.2011**, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of **Jaschhof, Kaehler, and Ginter** based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action, and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993) (Claims to a superconducting magnet which generates a

“uniform magnetic field” were not limited to the degree of magnetic field uniformity required for Nuclear Magnetic Resonance (NMR) imaging. Although the specification disclosed that the claimed magnet may be used in an NMR apparatus, the claims were not so limited.); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571-72, 7 USPQ2d 1057, 1064-1065 (Fed. Cir.), cert. denied, 488 U.S. 892 (1988) (Various limitations on which Applicants relied were not stated in the claims; the specification did not provide evidence indicating these limitations must be read into the claims to give meaning to the disputed terms.); *Ex parte McCullough*, 7 USPQ2d 1889, 1891 (Bd. Pat. App. & Inter. 1987) (Claimed electrode was rejected as obvious despite assertions that electrode functions differently than would be expected when used in nonaqueous battery since “although the demonstrated results may be germane to the patentability of a battery containing Applicants’ electrode, they are not germane to the patentability of the invention claimed on appeal.”). See MPEP § 2111 - § 2116.01, for additional case law relevant to claim interpretation.

Applicants argue that the examiner’s conclusion of obviousness is based on improper hindsight reasoning. However, “[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure, such a reconstruction is proper.” *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). Applicants may also argue that the combination of two or more references is “hindsight” because “express” motivation to

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combine the references is lacking. However, there is no requirement that an “express, written motivation to combine must appear in prior art references before a finding of obviousness.” See *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). **>See MPEP § 2141 and § 2143 for guidance regarding establishment of a prima facie case of obviousness.

Applicants argue that the examiner is applying an improper “obvious to try” rationale in support of an obviousness rejection. An “obvious to try” rationale may support a conclusion that a claim would have been obvious where one skilled in the art is choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success. “[A] person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely that product [was] not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.” *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007).

“The admonition that obvious to try’ is not the standard under § 103 has been directed mainly at two kinds of error. In some cases, what would have been obvious to try’ would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.... In others, what was obvious to try’ was to explore a new technology or general approach that seemed to be a promising field of

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experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.” In re O ’Farrell, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (citations omitted) (The court held the claimed method would have been obvious over the prior art relied upon because one reference contained a detailed enabling methodology, a suggestion to modify the prior art to produce the claimed invention, and evidence suggesting the modification would be successful.).

A suggestion or motivation to combine references is an appropriate method for determining obviousness; however it is just one of a number of valid rationales for doing so. The Court in KSR identified several exemplary rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in Graham. KSR, 550 U.S. at ___, 82 USPQ2d at 1395-97. See MPEP § 2141 and § 2143.

The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. When combined, the elements perform the same function as they did separately. The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

Applicants’ arguments having been found unpersuasive, the rejection has not been withdrawn.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARCIA ADE whose telephone number is (571)272-5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571.272.3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a SPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Garcia Ade
Examiner
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ga

/Vanel Frenel/
Primary Examiner, Art Unit 3687